

Knobbe Martens Olson & Bear LLP

Intellectual Property Law

2040 Main Street
Fourteenth Floor
Irvine, CA 92614
Tel 949-760-0404
Fax 949-760-9502
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May 13, 2004


Nancy W. Vensko, Reg. No. 36,298

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TO: Jasmine Chambers, Group Director
USPTO FACSIMILE NO.: 703-872-9306
USPTO REFERENCE: Applicant: Sibley et al.
Serial No.: 09/829,631 Filed: April 10, 2001
Title: THE ST-B17 SEROTONIN RECEPTOR
ATTORNEY: Nancy W. Vensko
PHONE NO.: 805-547-5585
ATTORNEY DOCKET NO.: NIH047.1CP1C1
TOTAL PAGES: 22 (INCLUDING COVER SHEET)
STATUTORY DEADLINE: June 9, 2004
DATE: May 13, 2004

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MESSAGE: Per fax filing of March 25, 2004 (original fax transmittal dated 3/25/04 and acknowledgment of receipt attached), re-attached for re-filing in the above-referenced application are:

REQUEST FOR REVIEW BY GROUP DIRECTOR OF ART UNIT 1631 in 2 pages;
Copy of Interview Summary in 3 pages; Copy of INFORMAL COMMUNICATION
FOR DISCUSSION PURPOSES ONLY and marked up copy of MPEP 201.06(c) in 9
pages; Copy of Office Action in 5 pages.

The Commissioner is hereby authorized to charge any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 11-1410.

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Knobbe Martens Olson & Bear LLP
Intellectual Property Law

1114 Marsh Street
San Luis Obispo CA 93401
Tel 805-547-5580
Fax 805-547-5590

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TO: Jasmine Chambers, Group Director
USPTO FACSIMILE NO.: 571-273-0200
USPTO REFERENCE: Applicant: Sibley et al.
Serial No.: 09/829,631
Filed: April 10, 2001
Title: THE ST-B17 SEROTONIN RECEPTOR
ATTORNEY: Nancy W. Vensko
PHONE NO.: 805-547-5585
ATTORNEY DOCKET NO.: NIH047.1CP1C1
TOTAL PAGES: 20 (INCLUDING COVER SHEET)
DOCKETING AGENT:
DATE: March 25, 2004

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San Luis Obispo CA 93401
Tel 805-547-5580
Fax 805-547-5590

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TO: Jasmine Chambers, Group Director
USPTO FACSIMILE No.: 571-273-0200
USPTO REFERENCE: Applicant: Sibley et al.
Serial No.: 09/829,631
Filed: April 10, 2001
Title: THE 5-HT_{1B} SEROTONIN RECEPTOR
ATTORNEY: Nancy W. Veneko
PHONE No.: 805-547-5585
ATTORNEY DOCKET No.: NIH047.1CP1C1

NIH047.1CP1C1

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Sibley et al.
Appl. No. : 09/829,631
Filed : April 10, 2001
For : THE 5-HT_{1B} SEROTONIN
RECEPTOR
Examiner : Allen, M.

Group Art Unit 1631

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REQUEST FOR REVIEW BY GROUP DIRECTOR OF ART UNIT 1631

United States Patent and Trademark Office
P.O. Box 1450
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Applicant hereby requests review by the group director of art unit 1631 of the issue whether by containing the desired set of claims rather than adding the desired set of claims by preliminary amendment, the continuation application does not contain new matter and cannot be redesignated as a continuation-in-part. Attached is a copy of an "Interview Summary" indicating, "The requirement for a CIP oath was not resolved and applicant may petition." Applicant requests this review by the group director of art unit 1631 instead of petition to the commissioner without prejudice.

Attached is "Informal Communication for Discussion Purposes Only" faxed in expectation of the interview summarized in "Interview Summary." The issue for review is set forth on page 4. To reiterate, applicant asked for consideration of the attached marked-up copy of MPEP 201.06(c) indicating that the Patent Office strongly recommends that a continuation application *contain* only the desired set of claims rather than *add* the desired set of claims by preliminary amendment. The filing of the desired set of claims (Claims 1-16) rather than adding the desired set of claims by preliminary amendment resulted in the office action (copy attached) determining that the continuation application contains *new matter* and must be *redesignated* as a continuation-in-part. Nevertheless, the MPEP additionally indicates that the prior set of claims

Appl. No. : 09/829,631
Filed : April 10, 2001

was properly incorporated by reference by a statement in the application transmittal letter specifically enumerating the prior application. There is no dispute that, other than the desired set of claims, the specification is identical to the prior specification (except for the introduction of SEQ ID identifiers). Assuming for the sake of argument that Claims 1-16 did not meet the requirement under 35 USC 112/1 for written description (although they were *not* rejected under 35 USC 112/1 for lack of written description), the claims have been *canceled* and replaced with Claims 17-28. By containing the desired set of claims rather than adding the desired set of claims by preliminary amendment, the continuation application does not contain new matter (although there is a dispute as to whether subsequently-canceled Claims 1-16 meet the requirement under 35 USC 112/1 for written description), the specification of which is otherwise identical to the prior specification (except for the introduction of SEQ ID identifiers), properly incorporates by reference the prior set of claims, and conforms with the procedure strongly recommended by the Patent Office, and therefore cannot be redesignated as a continuation-in-part.

Applicant hereby requests determination by the group director of art unit 1631 of the issue that, by containing the desired set of claims rather than adding the desired set of claims by preliminary amendment, the continuation application does not contain new matter and cannot be redesignated as a continuation-in-part. A shortened statutory period for reply was set to expire 9 March 2004, and the statutory period is set to expire 9 June 2004. A determination in time for Applicant to meet the deadline of 9 April or 9 May 2004 at the latest is respectfully requested.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 3/25/04

By: 

Nancy W. Vensko
Registration No. 36,298
Attorney of Record
Customer No. 20,995
(805) 547-5585

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